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2975 7590 03/02/2011 ALLEN, DYER, DOPPELT, MILBRATH & GILCHRIST P.A. 1401 CITRUS CENTER 255 SOUTH ORANGE AVENUE P.O. BOX 3791 ORLANDO, FL 32802-3791				
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MARIANO CONCILIO, FRANCESCO VARONE,  
and AMEDEO VENEROSO

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Appeal 2010-000524  
Application 10/725,193  
Technology Center 3600

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*Before* MURRIEL E. CRAWFORD, HUBERT C. LORIN, and BIBHU R.  
MOHANTY, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

### STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 16 to 41, and 43. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

Claim 16 is illustrative:

16. A method for executing an event-driven application in an electronic device including a smart-card, the application being resident in the smart-card and being decomposed into a central module and at least one complementary module, the method comprising:

managing interaction between the modules by a framework of the smart-card; and

after at least beginning execution of the central module by the framework based upon an external event, generating a new set of internal events by the framework for managing the at least one complementary module.

Appellants appeal the following rejections:

1. Claims 16 to 18, 20 to 26, 28 to 34, 36 to 41, and 43 under 35 U.S.C. § 103(a) as unpatentable over Valencia (US Pat. 5,380,991, iss. Jan. 10, 1995) in view of Coutts (US Pat. 6,311,165 B1, iss. Oct. 30, 2001).

2. Claims 19, 27, and 35 under 35 U.S.C. § 103(a) as unpatentable over Valencia in view of Coutts and Applicant's Admitted Prior Art (App. No. 10/725,193, Figs. 1 to 3, and Paras. [0001] to [0019]) (hereinafter "APA").

## ISSUE

Did the Examiner err in rejecting the claims because the prior art does not disclose the step of managing interactions between modules of an application resident in a smart card by a framework of the smart-card?

## FACTUAL FINDINGS

Valencia discloses a paperless redemption system which includes a smart card 2 which has a microcomputer 4, a memory 6, and a plurality of terminals 8 (col. 4, ll. 8 to 14).

The Examiner finds that the terminal 8 of Valencia reads on the framework, CPU 10 reads on the central module, and memory component 6 reads on a complementary module of claim 16.

## ANALYSIS

The Appellants argue that Valencia does not disclose an application resident on the smart card. The Examiner has not given the recitation in the claim regarding the application being resident on a smart card weight because the recitation is in the preamble of the claim.

The question of whether a preamble constitutes a limitation to a claim is a matter to be determined by the facts of each case in view of the claimed invention as a whole. *See In re Stencel*, 828 F.2d 751, 754 (Fed. Cir. 1987). The preamble of a claim does not limit the scope of the claim when it merely states intended use of the invention. *In re Pearson*, 494 F.2d 1399, 1403 (CCPA 1974). However, terms in a preamble are construed as limitations when they give life and meaning to the invention claimed. *Gerber Garment Tech., Inc. v. Lectra Sys., Inc.*, 916 F.2d 683, 688-89 (Fed. Cir. 1990)

(quoting *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 896 (Fed. Cir.), *cert. denied*, 469 U.S. 857 (1984)).

In the instant case, the preamble recites that the application on the smart card is decomposed into a central module and at least one complementary module. The first step in the body of the claim recites the step of managing the modules by a framework of the smart-card. The recitation of an application on a smart card that is decomposed into modules in the preamble gives life and meaning to the recitation in the first step in the body of the claim of managing *the modules*. Therefore, in our view the recitation in the preamble of an application resident in the smart-card that is decomposed into modules must be given weight when the patentability of claim 16 is determined.

We agree with the Appellants that the CPU 10 and memory 6 are not decomposed modules of an application on the smart card but rather components of the smart-card itself. Therefore, we will not sustain the rejection of claim 16 and claims 17, 18, 20 to 23 dependent thereon under 35 U.S.C. § 103(a).

We will also not sustain the rejections of independent claims 24 and 32 and claims 25, 26, 28 to 34, 36 to 41 and 43 dependent thereon because claims 24 and 32 likewise recite an application resident on a smart-card that is separated into modules.

We will also not sustain the Examiner's rejection of claims 19, 27 and 35 under 35 U.S.C. § 103(a) as being unpatentable over Coutts in view of Admitted Prior Art ("APA") because these claims depend on claims 16, 24 and 32 respectfully and thus include the recitation of an application resident

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on a smart card that is decomposed into modules that we found is missing in  
Coutts. APA does not cure this deficiency of Coutts.

### DECISION

The decision of the Examiner is reversed.

REVERSED

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